

REMARKS

The Examiner has rejected Claims 1-3, 9, 10, 12, 19, 26, and 33-38 under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent No. 5,960,170), in view of Feinberg (U.S. Patent App. No. 2002/0143825). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991). Applicant respectfully asserts that at least the first and third elements of the *prima facie* case of obviousness have not been met.

With respect to the first element of the *prima facie* case of obviousness, the Examiner states that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to add the functionality of Feinberg's search, mark and modify functions to the text editor of Chen's system, wherein Feinberg's modify function is set to delete the text as taught by Chen. Applicant respectfully disagrees with this proposition, especially in view of the vast evidence to the contrary.

For example, Chen relates to a virus scanning system, while Feinberg relates to a text rendering system. To simply glean features from a text rendering system, such as that of Feinberg, and combine the same with the *non-analogous art* of virus scanning systems, such as that of Chen would simply be improper. A text rendering system ensures the proper reading order of rendered text, while a virus scanning system detects viruses, malware, etc. "In order to rely on a reference as a basis for rejection of an

applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). In view of the vastly different types of problems a text rendering system addresses as opposed to a virus scanning system, the Examiner's proposed combination is inappropriate.

Further, contrary to the Examiner's arguments, it would have been unobvious to carry out the Examiner's proposed modification, "wherein Feinberg's modify function is set to delete the text as taught by Chen." The crux of Feinberg's invention is to render text. Thus, any use of Feinberg's technology to delete the same would simply not make sense. Thus, Feinberg's text rendering system *teaches away* from any sort of virus scanning system, where textual deletions are carried out. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986).

With respect to the third element of the *prima facie* case of obviousness, the Examiner continues to rely on the disclosure of "treatment objects" and "remedial routines" in Chen to make a prior art showing of applicant's claimed "virus removal routines comprising a text editor" (see all independent claims). Further, the Examiner relies on Chen's disclosure of "stripping or replacing infected portions" to make a prior art showing of applicant's claimed deletion of a "textual portion" of the file.

Applicant respectfully disagrees with this assertion. In particular, applicant contends that the simple mention of "strings" in Chen does not rise to the level of specificity of applicant's claimed "text." Only applicant teaches and claims a "text editor," operable to search and modify a "textual portion" of a file (emphasis added), as claimed.

It appears that the Examiner has not yet addressed this argument. In any future office action, a specific response is respectfully requested.

Further, the Examiner has relied on the following excerpt from Chen to make a prior art showing of applicant's claimed "wherein the text editor comprises a mark function operable to mark text matching the regular expression that was found by the search function." See all independent claims.

"In the second type of detection, the strings comprise adjacent portions of the viruses and thus the iterative scan can also detect the virus (rather than just limit the amount of viruses that could be present followed by a full virus signature transmission). In the second type of detection, therefore, additional information about the files including strings and the location of the strings is provided. Specifically, in the second type of detection, if the initial virus detection object indicates that 5 targeted files include A1 or B1, then an identification of which files include which string is retained, as well as a marker so that a determination could be made as to whether the adjacent string A2 or B2 respectively followed string A1 or B1 in a targeted file. In this fashion, the number of viruses which are potentially present can be rapidly minimized and efforts are not duplicated since the full signature does not have to be transmitted after transmission of virus portions." (col. 14, lines 32-48)

Applicant respectfully disagrees with this assertion. Specifically, the marker of Chen merely provides a technique for making a determination as to whether an adjacent string A2 or B2, respectively, follows string A1 or B1 in a targeted file. In sharp contrast, applicant's claimed marker functions specifically to "mark text matching the regular expression that was found by the search function" (emphasis added). Only applicant teaches and claims such a marker adapted for the specific marking of matched text, as claimed.

Still yet, the Examiner has relied on the following excerpt from Chen to make a prior art showing of applicant's claimed "the delete function is operable to delete text" based on a marker function. See all of the independent claims.

"Various remedial routines are provided by the cleaning module 460. Dependent upon the conditions presented at the client 300 and the type of virus detected, the remedial routines can take immediate actions such as deleting a file, stripping out infected portions of a file, or replacing infected portions with a benign portion." (see col. 15, line 54 et seq.)

Specifically, the Examiner relies on the "stripping out [of] infected portions" to make a prior art showing of applicant's claimed "delete text" based on a marker. The mere suggestion of stripping infected portions, however, in no way rises to the specificity of applicant's claimed "delet[ion of] text" based on a marker. Further, for the reasons set forth above, Chen's single marker does not even meet applicant's claimed marker-related functionality and, in a similar fashion, Chen does not suggest the deletion of text based on such specific marker.

The Examiner continues by admitting that "Chen does not explicitly teach that the search and mark functions are operable to search for and mark a start of text to be marked and an end of text to be marked, while the delete function is operable to delete text between the start marker and end marker, as claimed" (emphasis added). The Examiner continues by relying on Feinberg to meet such limitations.

However, Feinberg makes absolutely no mention of any sort of a delete function, and thus is unable to meet applicant's claimed delete function that is operable to delete text between the start marker and end marker, which the Examiner admits to be absent from Chen. Further, such delete function would not even make sense in the context of Feinberg, since the purpose of such invention is to render text, not delete it.

Applicant respectfully maintains that the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to at least suggest all of applicant's claim limitations. Again, a notice of allowance or a

specific prior art showing of each of the foregoing limitations, in combination with the remaining claim elements, is respectfully requested.

Nevertheless, in the spirit of expediting the prosecution of the present application, applicant has amended each of the independent claims to include at least a portion of the subject matter of Claims 34 and 35. The Examiner has simply dismissed such limitations under Official Notice. In response, applicant argues that such features provide an enhanced text editor that is ideally suited for removing text-based viruses. Applicant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

“If the applicant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position.” See MPEP 2144.03.

Applicant further notes that the Examiner’s application of the prior art to each of applicant’s dependent claims is further replete with deficiencies. Just by way of example, after reviewing the excerpts from Chen and Feinberg used to reject Claim 34, applicant notes at least the following emphasized limitations which are simply non-existent in such references, contrary to the Examiner’s arguments:

“wherein the text editor is capable of actions including a load current module and start edit action, a load particular module and start edit action, a match current line or any subsequent line action, a match any subsequent line action, a match current line action, a match next line action, a match last viable line action, a match last consecutive line action, a delete marked positions action, a global pattern match and delete action, a delete a single word processor macro reference action, a delete all word processor macro references action.”

Further, with respect to applicant’s claimed “reset cursor position to beginning of the file action” (see Claim 34 et al.), applicant again formally requests a specific showing

of the subject matter in ALL of the claims, including the present limitation, in any future action.

Still yet, the Examiner relies on Fig. 4 of Feinberg to make a prior art showing of Claim 37 in the following manner:

“wherein the special characters include a branch [e.g. dash], a piece [e.g. separator], an atom [e.g. number], and a range [e.g. end].”

Such mapping between applicant’s claim terms and the prior art does not, however, meet applicant’s claimed special characters, since the definitions for such terms from page 18 of the originally-filed specification are clearly not met.

Again, a notice of allowance or a specific prior art showing of all of the claim elements, in combination with the remaining claim limitations, is respectfully requested.

Applicant further brings the Examiner’s attention to the subject matter of added Claims 39-42 which applicant believes to be novel over the prior art, when taken in combination with the remaining claimed features:

“wherein the atom includes a regular expression in parentheses” (see Claim 39);

“wherein the piece includes the atom followed by characters” (see Claim 40);

“wherein the branch includes a plurality of the pieces, concatenated” (see Claim 41); and

“wherein the range includes a sequence of characters enclosed in ‘[]’” (see Claim 42).

Again, a notice of allowance or a specific prior art showing of all of the claim elements, in combination with the remaining claim limitations, is respectfully requested.

Appl. No. 09/988,600

Reply to Office action of November 2, 2004

Reconsideration is respectfully requested.

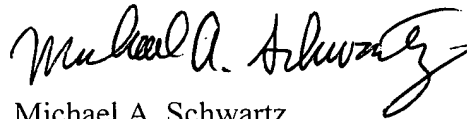
Additional Fees:

The Commissioner is hereby authorized to charge any insufficient fees or credit any overpayment associated with this application to Deposit Account No. 19-5127 (19903.0002).

Conclusion

In view of the foregoing, all of the Examiner's rejections to the claims are believed to be overcome. The Applicants respectfully request reconsideration and issuance of a Notice of Allowance for all the claims remaining in the application. Should the Examiner feel further communication would facilitate prosecution, he is urged to call the undersigned at the phone number provided below.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Michael A. Schwartz", with a stylized flourish at the end.

Michael A. Schwartz
Reg. No. 40,161

Dated: November 29, 2004

Swidler Berlin Shereff Friedman, LLP
3000 K Street, N.W., Suite 300
Washington, D.C. 20007
(202) 424-7500